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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,292	11/13/2001	Jurgen Veil	103797-221-NP	5332
24964	7590	04/07/2004	EXAMINER	
GOODWIN PROCTER L.L.P 103 EISENHOWER PARKWAY ROSELAND, NJ 07068			COLILLA, DANIEL JAMES	
			ART UNIT	PAPER NUMBER

2854

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,292

Applicant(s)

VEIL, JURGEN

☒

Examiner

Dan Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-18 is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 2,3,6,8,11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 4-5, 7, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bird (US 4,841,903) in view of Weber (US 2,008,974).

With respect to claim 1, Bird discloses the claimed method for printing on a printing substrate except for the step of dividing the printing substrate into a plurality of blank substrates. Bird discloses that printing with more than one ink system is conventional (Bird, col. 1, lines 6-10). Thus Bird discloses printing an image with one image printing station, and Bird teaches coating certain areas with ink with a second image printing station. Bird further discloses that it is desirable to print packaging blanks (i.e. product containers, videocassette boxes, col. 2, lines 34-38). In col. 1, lines 47-50, Bird discloses that protective coating compositions (lacquer) are applied over printed images for providing glossy or matte finishes. In col. 1, lines 67-68 and col. 2, lines 1-12, Bird discloses that the wet condition of the printing ink at the time a coating composition is applied there over produces a visible change in the appearance of the portion of the coating overlying the printed images including the certain areas printed by the second image printing station. This application of the coating over printed images results in co-mingling of the ink and the coating at the certain areas thus the two substances are absorbed into one another to a certain extent. *Note that phrases such as "intended for application of an adhesive" or "for*

application of adhesive” are considered “for use” statements which do not positively recite any method or structure and therefore have no patentable weight in this method claim.

Weber teaches dividing a packaging substrate 4 into a plurality of blank substrates 36 as shown in Figure 1 of Weber. It would have been obvious to combine the teaching of Weber with the method disclosed by Bird for the advantage of the strength that corrugated board (as taught by Weber) gives packaging materials.

With respect to claim 4, the phrase “a small amount of pigments” uses the comparable term, “small” with no basis with which to compare it. The second inking system disclosed by Bird contains either a certain amount of pigment or no pigment. In the case that it contains a certain amount of pigment, it is conceivable that the amount of pigment is small compared to an ink containing more pigment.

With respect to claim 5, while Bird does not explicitly disclose that the coating is colorless, protective coatings are generally colorless and are meant only to protect the image and not change the image with color.

With respect to claim 7, Bird discloses radiant dryer 16 (col. 6, lines 53-55).

With respect to claim 9, Bird in view of Weber discloses the claimed method as mentioned above with respect to claim 1, and Bird additionally discloses that resin binder material is conventionally used in lithographic ink (col. 3, lines 26-29). Figure 1 of Bird discloses that the ink is used in an offset press. This ink when used in a second image printing image station would apply a binder to the above-mentioned certain areas.

With respect to claim 10, Bird discloses that the binder can be a varnish (col. 3, lines 29-30).

Allowable Subject Matter

3. Claims 16-18 are allowed.

4. Claims 2-3, 6, 8 and 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter:

Claims 16-18 have been allowed primarily for the step of applying a lacquer over the surface of the printing substrate; the lacquer being absorbed by a binder and interacting with at least two different ink systems such that degrees of gloss vary amount areas of said at least two different ink systems.

Claim 2 has been indicated as containing allowable subject matter primarily for the two ink systems differing with respect to lacquer absorption capacities.

Claim 3 has been indicated as containing allowable subject matter primarily for the two ink systems being treated differently by curing and/or drying.

Claim 11 has been indicated as containing allowable subject matter primarily because the ink film and the binder are treated differently buy curing and/or drying.

Claim 12 has been indicated as containing allowable subject matter because the ink film and binder differ from one another with respect to lacquer absorptive capacities.

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Response to Arguments

6. Applicant's arguments with respect to the claims have been considered and have persuaded the examiner of removing the 112, first paragraph, rejection and the Stadler et al. prior art rejection.


A new prior art ground(s) of rejection has been applied as indicated above.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571) 272-2157. The examiner can normally be reached Tues.-Fri. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703) 872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571) 272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 1, 2004


Dan Colilla
Primary Examiner
Art Unit 2854